

REMARKS

35 U.S.C. §102

The Office Action rejected claims 1-4, 9-12, 14, 20, 21, 28-31, 33-38, 40, 41, 43, 47-49, 52, 55, and 57 are rejected under 35 U.S.C. §102(e) as being anticipated by Underwood et al. (6,277,112) Applicant disagree with the validity of this rejection.

The subject application, as filed, the subject application properly claimed benefit under 35 U.S.C. §120 to U.S. Patent 6,277,112 to Underwood et al. (application number 09/026,851.)

Previously, applicant cited to M.P.E.P. §706.02(b) which provides that a rejection based on 35 U.S.C. 102(e) can be overcome by perfecting priority under 35 U.S.C. §120. Accordingly, a rejection based on 35 U.S.C. §102(e) using Underwood et al. is improper since the subject application already contains a claim for benefit under 35 U.S.C. §120 to Underwood et al.

The Office Action responded by citing M.P.E.P. §2136.04 and *Ex Parte* Des Ormeaux, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992).

Applicant disagrees. Again, the M.P.E.P. clearly states in §706.02(b) that overcoming a rejection under 35 U.S.C. §102(e) may be accomplished by a perfected benefit claim to a prior application. Given a perfected claim, the earliest filing date afforded to the claims in question is no longer before the critical date of the reference.

The Office Action's rejection is under 35 U.S.C. §102. Accordingly, the Office Action's rejection concedes that the subject matter of the rejected claims is in the parent application (i.e., the cited reference) itself. Therefore, the rejected claims are entitled to a filing date of the cited reference. Thus, it is impossible to satisfy the requirement under 35 U.S.C. §102(e), namely that the invention (the

rejected claims) were described in . . . an application for patent filed . . . before the invention (the rejected claims) by the applicant for patent.

The question of whether the invention was "by another" is irrelevant if the critical date of the reference is no longer sufficient.

Applicant notes that the section cited by the Office Action, §2136.04, concerns the meaning of "by another" with respect to the inventive entity. Applicant fully concedes that a different inventive entity is *prima facie* evidence that the reference is "by another." Applicant further notes that in *Ex Parte Des Ormeaux* "[t]he Board found that the patent was "by another" and thus could be used in a 35 U.S.C. §102(e)/103 rejection." (See M.P.E.P. §2136.04.) Clearly, the meaning of "by another" in the context of a §102(e)/103 rejection holds a different significance. In such a case, a claim of benefit to an earlier application may not be possible due to the addition subject matter in the rejected claims that requires the rejection to be a §102(e)/103 based rejection rather than a rejection based upon §102 alone. If the rejection in *Ex Parte Des Ormeaux* was merely a §102(e) rejection and the cited reference was a parent to the CIP, then it is likely that the applicant in that case could have also made a claim to priority.

Applicant requests withdrawal of this rejection.

Double Patenting

The Office Action rejected claims 1-4, 9-12, 14, 20-25, 28-38, 40, 41, 43, and 47-57 are rejected under judicial double patenting over claims in U.S. Patent no. 6,277,112. The Office Action states that the claims are not patentably distinct from each other because they represent an obvious change in scope. Applicant disagrees that the Office Action has established a proper basis for such a rejection. Applicant agrees that the claims at issue are clearly different in scope. However, merely claiming that the difference is obvious is insufficient for such a rejection.

Although Applicant disagrees with this rejection, in the interest of expediting prosecution, a terminal disclaimer is submitted herewith.


Allowable Subject Matter

Applicant's attorney wishes to express gratitude for the indication that claims 5-8, 13, 15-19, 26, 27, 39, 42, and 44-46 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

SUMMARY

Applicant believes all outstanding issue raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,

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